

I. Remarks

The Office Action mailed November 29, 2006 has been received and carefully considered. Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

- Under **35 U.S.C. §102(e)**, the Examiner rejects claims 1-3, 6, 14, 15, and 17-20 as being anticipated by Lent *et al.* (US Patent No. 6324524) ("Lent").
- Under **35 U.S.C. §103(a)**, the Examiner rejects claims 4, 5, 7-13, and 16 as being obvious over Lent.

A. Response to Rejection of Claims 1-3, 6, 14, 15, and 17-20 under 35 U.S.C. §102(e)

Claims 1-3, 6, 14, 15, and 17-20 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Lent. This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a *prima facie* case of anticipation. In *re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *Id.*. "In addition, the prior art reference must be enabling." *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In *re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). Such possession is

effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id.

The Office Action sets forth the rejection of claim 1 on page 3. The Office Action asserts that as per claim 1, Lent discloses a system of producing and sending a loan document to a customer. The Office Action relies generally on the Abstract, Figures 1-5 and 12-14 and related text in the Specification. The Office Action refers also to paragraphs 20-55, 63 and 68.

Applicants have reviewed the Office Action comments and the teachings of Lent regarding claim 1. Applicants respectfully submit that Lent fails to teach the claimed invention.

Lent contains no disclosure of a system wherein the "...web site receives the loan information and merges the loan information with a loan application form to produce a loan application..." as recited in claim 1 of the present invention. On the contrary, Lent discloses, at best, a system as depicted in Lent's Fig. 3 wherein applicant data is obtained (i.e., step 304), applicant data is validated (i.e., step 306), applicant data is parsed (i.e., step 311) and applicant data is tested (i.e., steps 312-316). As depicted in Figures 1-3 and described in Lent's corresponding disclosure, Lent, at most, proposes presenting an online application for credit to applicants, validating the data and processing it. There is no disclosure of a system which "receives the loan information and **merges the loan information with a loan application form to produce a loan application**," as recited by claim 1. Lent, at best, obtains credit applicant data, but Lent does not disclose merging the data with a loan application form to produce a loan application. Lent thus fails to disclose the above limitations of claim 1 or the similar limitations of claim 6.

Lent further fails to teach the features of claim 1 including “the loan processor sends the loan document to the customer through one of e-mail, facsimile, the network, a first printer coupled to the network, and a second printer coupled to another network.” An online offer for credit is not “send[ing] the loan document to the customer” wherein the loan document is “based on the loan application” as required by claim 1 or the similar limitations in claim 6.

Lent does not disclose at least the above discussed elements of the independent claims. Thus the Office has failed to establish a *prima facie* case of anticipation.

Regarding claims 2-3, 14-15 and 17-20 these claims are dependent upon independent claims 1 or 6. Thus, since independent claims 1 and 6 should be allowable as discussed above, the dependent claims should also be allowable at least by virtue of their dependency on independent claims 1 or 6.

Withdrawal of the 35 U.S.C. 102 (e) rejection based on the prior art is respectfully requested.

B. Response to Rejection of Claims 4, 5, 7-13 and 16 under 35 U.S.C. §103 (a)

Claims 4, 5, 7-13 and 16 are currently rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Lent (US Patent No. 6324524). Applicants hereby respectfully traverse this rejection.

The Office Action has failed to set forth a *prima facie* case of obviousness for the claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner

proposed. Ruiz v. A.B. Chance Co., 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

As discussed above, Lent fails to teach or disclose the claimed invention. The proposed modifications would not remedy the previously identified deficiencies. Thus, independent claims 1, 6, and 7 are not obvious over Lent.

Furthermore, the Office admits that “Lent fails to teach that cashing a check indicates acceptance by the customer of the terms listed in the loan document, checking the validity of the check, and the loan document includes insurance information relating to the loan.” (Office Action, page 5). The Office Action fails to provide any motivation to modify Lent to include the admittedly missing features. The proposed motivation of the Office is that it “greatly improves the efficiency of the system by providing an easier and faster way of processing loan contracts and a system that is user friendly.” (Office Action, pages 5-6). Lent does not disclose sending a check. On the contrary, Lent is directed to a “system and method ... for presenting multiple custom offers to an applicant for credit over a network.” (Lent Abstract). As is obvious from the title, Lent also is directed towards a more immediate application (i.e. - “Method and Apparatus for an Account Level Offer of Credit and **Real Time** Balance Transfer” (Lent title, emphasis added)). Lent thus teaches away from “sending a check to a customer” as required by claims 4 and 7. Because Lent does not even disclose a check and teaches away from the use of offers that are not real time, this proposed motivation clearly fails.

Accordingly, the Office Action has failed to provide any proper motivation for modifying Lent to remedy the admitted deficiencies. Thus the Office has failed to establish a prima facie case of obviousness.

The Court of Appeals for the Federal Circuit has interpreted that *if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 837F2d1071, 5USPQ2d1596.*

Since claims 4 and 5 are dependent depend from independent claim 1, and claims 8-13 and 16 depend from independent claim 7, they are also not obvious by virtue of their dependency on the independent claims.

For at least these reasons, Applicants respectfully request that the instant rejection of claims 4, 5, 7-13, and 16 be withdrawn.


II. Conclusion

For all the reasons set forth above, it is respectfully submitted that all outstanding rejections have been overcome or rendered moot. Applicants accordingly submit that these claims are in a condition for allowance. Reconsideration and allowance of all claims are respectfully requested.

The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

In the event any additional fees are due, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

 2/27/07

Steve Schreiner
Reg. No. 43097

Hunton & Williams LLP
1900 K Street, N.W.
Washington, D.C. 20006-1109
Phone: (202) 955-1587
Fax: (202) 778-2201

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